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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/423,619      | 11/15/1999  | HANS SEITER          |                     | 6961             |

7590                    07/15/2003

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[REDACTED] EXAMINER

ARNOLD III, TROY G

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

3728

DATE MAILED: 07/15/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/423,619             | SEITER, HANS        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Troy Arnold            | 3728                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 May 2003.

2a) This action is **FINAL**.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 26 and 31-35 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 31 is/are allowed.

6) Claim(s) 26,32,33 and 35 is/are rejected.

7) Claim(s) 34 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-20 – cancelled

Claims 21-25 – non-elected

Claims 27-30 – cancelled

Claims 26 and 31-35 – examined in instant action, paper No. 27.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The first, second and third “cushioned layers are located...to aid the venous outflow of blood” is redundant to claim 31, lines 12-14 which renders the claim indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Pendergast. Regarding claim 32, Pendergast teaches an inner sole 10 comprising a sole base body 18 defining a sole surface (the upper surface) and having the areas specifically as claimed, a sole cover layer 12, a first cushioned layer 60 in the area claimed, a second cushioned layer 58 in the area claimed, a third cushioned layer 56 in the area claimed, a fourth cushioned layer 52 in the area claimed, and a fifth cushioned layer 54 in the area claimed. Regarding claim 35, the above cushioned areas are located at support areas of the sole base body 18. See Fig 3 of Pendergast. (Note: In claims 26, 31, 34 and 35, the phrase "which positively affect a contraction of the musculature of the foot, serving thereby to aid the venous outflow of blood" is functional language which recites no distinct structural limitations. It is submitted that the structures of the references relied upon will also positively affect a contraction of the musculature of the foot, which will serve to aid the venous outflow of blood, inasmuch as the instant invention will.)

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast in view of Wang and Levy. Pendergast teaches all the limitations of claim 26 except each cushioned layer being divided into fields, as claimed. (The other limitations are taught as above in the 102 rejection.) The first cushioned layer 25,26,30,32,34 is divided into raised fields, as claimed. Wang teaches an insole with a heel cushion divided into fields. Levy teaches an insole with a forefoot/metatarsal cushion divided into raised fields. It would have been obvious in view of either Wang or Levy to one of ordinary skill in the art at the time the invention was made to divide the second 22 and third 20 layers of the insole of Pendergast into raised fields, specifically as claimed, in order to allow the other areas of the foot to benefit from the differing hardness/resiliency of the fields of the first layer.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast in view of Wang. Pendergast as modified regarding claim 32 teaches all the limitations of claim 33 except the fourth cushioned layer being oval in shape and the fifth cushioned layer being in the shape of a sickle. Wang teaches an insole which has a heel cushion which is substantially oval in shape and a plantar arch cushion layer which is sickle-shaped. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the fourth and fifth cushions of Pendergast shaped as ovals and sickles respectively; this would appear to be an arbitrary matter of design choice. Further, the references cited but not relied upon teach a variety of different shapes and orientations for cushion areas in shoe insoles.

***Allowable Subject Matter***

Claim 31 is allowed.

Claim 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 14 January 2002 have been fully considered but they are not persuasive. Regarding the remarks on page 4, contrary to the Applicants assertions, items 25, 26, 30, 32 and 34 may be termed "cushions" in meeting the limitations of the claims as above. Together they form a first cushioned layer in the forefoot area. Each defines a surface which is raised with respect to the upper surface of the sole base body 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-0302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold  
Examiner  
Art Unit 3728

TGA  
July 10, 2003



SHIAN LUONG  
PRIMARY EXAMINER